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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/359,359	07/23/99	MATYJASZEWSKI	K 5344-0017-23

IM22/1018
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EXAMINER	
PASTERCZYK, J	
ART UNIT	PAPER NUMBER

1755

DATE MAILED:

10/18/01

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/359,359

Applicant(s)

Matyjaszewski et al.

Examiner

J. Pasterczyk

Art Unit

1755



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on Jul 23, 2001

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 68-116 is/are pending in the application.

4a) Of the above, claim(s) 81-116 is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 68-80 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☒ Claims 68-116 are subject to restriction and/or election requirement.

Application Papers

9) ☒ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____.
- ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☒ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

20) ☐ Other:

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1. This Office action is in response to the amendment filed 7/23/01 and refers to the first Office action on the merits mailed 4/23/01. Claims 68, 69, 72, 73 and 75-80 are under consideration due to the previous restriction requirement and election of species, with claims 70, 71, 74 and 81-116 withdrawn from consideration due to this restriction and election.

2. The abstract of the disclosure is objected to because it is very broad and nonspecific as to the actual chemical identities of these initiators. Correction is required. See MPEP § 608.01(b).

3. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

4. Claims 68, 69, 72, 73, and 75-80 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claims are not commensurate in scope with the enabling disclosure because they are omnibus and functionally claimed. Furthermore, many of the supposed limitations to the initiators in the claims are actually to the process to be carried out by them or to the substrates on which the initiators are to act so that they fail to further limit the initiators themselves, instead appearing to be intended use recitations. In addition, there appears to be no disclosure of how to use the initiator species elected, although examples 270-271 disclose how to make it.

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5. Claims 68, 69, 72, 73, and 75-80 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims fail to define the metes and bounds of the invention because they are omnibus and functionally claimed. Furthermore, many of the supposed limitations to the initiators in the claims are actually to the process to be carried out by them or to the substrates on which the initiators are to act so that they fail to further limit the initiators themselves, instead appearing to be intended use recitations.

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 68, 69, 72, 73, and 75-80 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over MacLeay as cited in the previous Office action.

The invention appears to reside in the presence in one initiator of two functional groups, one which can polymerize via radical polymerization processes, the other which can polymerize via non-radical processes. The examples of table I, cols. 43-44 of MacKeay appear to fit that description since they have both a diazo functional group as well as a halogen functional group, the former being capable of non-ATRP polymerization, the latter being capable of ATRP polymerization under the proper conditions. Hence the prior art appears to anticipate and render obvious the present claims. Applicants arguments to the contrary are unavailing since it is not

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clear what the structure of the claimed species is that would make it have a functional group that would activate the halogen atom toward ATRP polymerization to the exclusion of any reaction conditions a practitioner may be motivated to apply to the reaction.

Since the prior art appears to disclose the present invention on the basis of inherent property characteristics which would either anticipate or render obvious the present claims, and alternative 102/103 rejection is deemed appropriate, and the burden that it does or does not shifts to applicants as in *In re Best*, 195 USPQ 430, 433 (CCPA 1977).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Pasterczyk whose telephone number is (703) 308-3497. The examiner can normally be reached on M-R from 8:30 to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell, can be reached on (703) 308-3823. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-5433.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



J. Pasterczyk

10/10/01



Mark L. Bell
Supervisory Patent Examiner
Technology Center 1700